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OFFICE OF PETITIONS

In re Application of	:
Bruce D. Weintraub et al	:
Application No. 09/813,398	: DECISION ON PETITION
Filed: March 20, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. UOFMD.003C1	:

This is a decision on the petition under 37 CFR 1.78(a)(2), filed December 4, 2001, which is being treated as a petition under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 USC § 365(c) for the benefit of one or more prior filed international applications designating the United States of America (Application No. PCT/US99/05908, filed March 19, 1999, and Application No. PCT/US98/19772, filed September 22, 1998).

The petition is dismissed as moot for the reason stated below.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of one or more prior filed nonprovisional applications or international applications under 35 USC § 365(c) must be accompanied by:

- (1) the surcharge of \$1,280 set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional; and
- (3) the specification must contain or be amended to contain a reference to each prior filed copending nonprovisional or international application or be included in an application data sheet (ADS) (37 CFR 1.76) as required by 35 USC 120 and 37 CFR

1.78(a)(2). The Commissioner may require additional information where there is a question whether the delay was unintentional.

While the reference to the prior filed international applications was not included in the manner specifically set forth in 37 CFR 1.78(a)(2), i.e., the reference failed to indicate that the international applications designated the United States of America and were published in English under PCT Article 21(2),¹ the first sentence following the title of the specification did in fact include a reference to the prior filed international applications. Therefore, since the application will be scheduled for publication on the basis of the information concerning the claim contained in the specification as provided by 35 USC 120 and 37 CFR 1.78(a)(2), the filing of the instant petition under 37 CFR 1.78(a)(3) is unnecessary and is dismissed as involving a moot issue.

In view of the above, no fee is required for the instant petition. Therefore, as authorized, the \$1,280 fee submitted with the petition will be credited to Deposit Account No. 11-1410 in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to the Office of Initial Patent Examination Division for mailing of a corrected filing receipt with the projected publication date. Afterwards, this application will be forwarded to Technology Center AU 1653 for processing the amendment filed December 4, 2001 and for consideration by the examiner of the claim under 35 USC 365(c) and 37 CFR 1.78(a)(2) for the benefit of the prior filed international applications, Application Nos. PCT/US99/05908, filed March 19, 1999, and PCT/US98/19772, filed September 22, 1998.



Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ The requirement in 37 CFR 1.78(a)(2) for a statement that the reference to the international application must indicate whether the international application was published under PCT Article 21(2) in English was eliminated effective December 28, 2001. Note 66 F.R. 67087, at 67088 (Dec. 28, 2001).